



Attorney's Docket No.: 42390P8085

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Silvester

Application No.: 09/470,669

Filed: 12/23/1999

For: NOTEBOOK COMPUTER WITH  
INDEPENDENTLY FUNCTIONAL,  
DOCKABLE CORE COMPUTER

Examiner: Vu, Trisha U.

Art Unit: 2112

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

NEW APPEAL BRIEF  
IN SUPPORT OF APPELLANTS' APPEAL  
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Dear Sir:

The Appellants hereby submit this New Appeal Brief correcting the Appeal Brief of January 26, 2005, in response to the Office action mailed May 17, 2005 and in support of their appeal from a final decision by the Examiner, mailed August 24, 2004, in the above-captioned case. The Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

---

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on \_\_\_\_\_

July 13, 2005

Date of Deposit

Debbie Casias

Name of Person Mailing Correspondence

*Debbie Casias*

Signature

July 13, 2005

Date

## TABLE OF CONTENTS

I.	<u>REAL PARTY IN INTEREST</u>	3
II.	<u>RELATED APPEALS NAD INTERFERENCES</u>	3
III.	<u>STATUS OF THE CLAIMS</u>	3
IV.	<u>STATUS OF AMENDMENTS</u>	3
V.	<u>SUMMARY OF THE INVENTION</u>	4
VI.	<u>ISSUES</u>	6
VII.	<u>GROUPING OF CLAIMS</u>	6
VIII.	<u>ARGUMENT</u>	7
IX.	<u>CONCLUSION</u>	10
X.	<u>APPENDIX A</u>	11

## **I. REAL PARTY IN INTEREST**

The real party in interest is Intel Corporation, a corporation of Delaware having a principle place of business at 2200 Mission College Blvd., Santa Clara, CA 95052.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

## **III. STATUS OF THE CLAIMS**

In this application, claims 1-5, 7-12, and 14-20 are pending.

Examiner rejected claims 1-5, 7-9, 12, 14, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,999,997 (hereinafter “Pipes”) in view of U.S. Patent 6,128,661 (hereinafter “Flanagin”).

Examiner rejected claims 10, 11, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Pipes in view of Flanagin, and further in view of U.S. Patent 5,884,049 (hereinafter “Atkinson”).

Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Pipes in view of Flanagin as applied to claim 12, and further in view of U.S. Patent 5,754,798 (hereinafter “Uehara”).

## **IV. STATUS OF AMENDMENTS**

A final office action was mailed August 24, 2004 rejecting claims 1-5, 7-12, and 14-20 for the reasons specified above. A Notice of Appeal was filed January 24, 2005.

The claims found in the Appendix of this Appeal Brief reflect the claims as they are understood by the Applicant to stand at the date of this appeal.

## **V. SUMMARY OF THE INVENTION**

Notebook computers are becoming increasingly powerful, able to effortlessly run applications that include presentation graphics, spreadsheets, and word processors. Unfortunately, notebook computers may be unnecessarily large and heavy for certain applications. For example, a notebook computer may include applications to schedule appointments in an electronic calendar or to store names and numbers in an electronic address book. If a user intends to use only these applications during a particular period of time, a good portion of the bulk of a typical notebook computer may be superfluous. Instead, all that may be needed is a small, hand-held device such as a personal data assistant (PDA). (BACKGROUND, page 2, lines 8-18)

Unfortunately, to realize the advantages of both a PDA for running simple applications and a notebook computer for running more advanced applications, a user must purchase one of each. Much of the electronics contained in a PDA and in a notebook computer, however, is redundant. (BACKGROUND, page 2, lines 19-22)

The present invention is presented in Claim 1 as an electronic device. The elements of Claim 1 are provided below with reference to the examples in the drawings and the representative descriptions of the preferred embodiments in the specification. In Claim 1, the device comprises:

- a housing 101 to have the device docked 110 into a notebook computer 100 (page 5, lines 1-2);
- 2) having a memory 235 to store a first operating system (page 9, lines 9-10);
- an interface 260 disposed on a surface of the housing to enable communication between the device and the notebook computer when the device is docked (page 6, lines 5-11);
- a memory 210 to store a second operating system, the second operating system is smaller in size and provides less functionality than the first operating system (page 9, lines 6-8); and

a central processing unit (CPU) 200 to operate as a system processor of the notebook computer 100 when the device is docked and to operate as a system CPU of the device 101 when the device is undocked (page 7, lines 11-23).

Claim 12 is directed to a notebook computer. The elements of Claim 12 are provided below with reference to the examples in the drawings. Representative descriptions of the preferred embodiments in the specification may be found in the locations indicated above with respect to Claim 1. In Claim 12, the computer comprises

a docking port 110 to receive a hand-held core computer 101 having a Central Processing Unit (CPU) 200 to operate as a system CPU of the notebook computer 100 when the device is docked, and to operate as a system CPU of the core computer when the core computer is undocked, the hand-held core including a memory 210 to store a first operating system;

an interface 260 in the docking port to enable communication between the core computer and the notebook computer when the core computer is docked; and

a memory 235 to store a second operating system, the second operating system is larger in size and has greater functionality than the first operating system.

Claim 17 is directed to a method of operating a computer. The elements of Claim 12 are provided below with reference to the examples in the drawings. Again, representative descriptions of the preferred embodiments in the specification may be found in the locations indicated above with respect to Claim 1. In Claim 17, the method comprises operating a Central Processing Unit (CPU) 200 as a system CPU of a notebook computer 100 when a core computer 101 is docked in a docking port 110 of the notebook computer, the notebook computer including a memory 235 to store a first operating system; and

operating the CPU 200 as a system CPU of the core computer 101 when the core computer is undocked, the core computer including a memory 210 to store a second operating system , the

second operating system is smaller in size and provides less functionality than the first operating system.

## **VI. ISSUES PRESENTED**

In the Final Office Action mailed August 24, 2004, the Examiner has:

- (1) continued a rejection under Section 103 of Claim(s) of claims 1-5, 7-9, 12, 14, and 17-19 based on Pipes in view of Flanagin.
- (2) continued a rejection under Section 103 of Claim(s) of claims 10, 11, 15, and 20 based on Pipes in view of Flanagin, and further in view of Atkinson.
- (3) continued a rejection under Section 103 of Claim(s) of claim 16 based on Pipes in view of Flanagin as applied to claim 12, and further in view of Uehara.

The question presented on this Appeal is:

- (1) Whether the combination of Pipes in view of Flanagin renders the claimed invention obvious?

## **VII. GROUPING OF CLAIMS**

All pending claims (1-5, 7-12, 14-20) stand or fall together.

**VIII. ARGUMENT; REJECTION OF THE PRESENT INVENTION IS IMPROPER  
SINCE ONE SKILLED IN THE ART WITH KNOWLEDGE OF THE PRIOR ART WOULD  
NOT HAVE USED THE PRIOR ART TO COME UP WITH THE INVENTION AS  
CLAIMED**

*Question 1 -- Whether the combination of Pipes in view of Flanagin renders the claimed  
invention obvious?*

THE PRESENT CLAIMS INCLUDE LIMITATIONS NOT DISCLOSED IN EITHER  
PIPES NOR FLANAGIN

TO MODIFY PIPES WOULD DESTROY THE INTENDED PURPOSE OF PIPES

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant's independent claims 1, 12, and 17, include limitations that are not disclosed nor suggested by the Pipes or Flanagin references. As a result, Applicant's independent claims are patentable over the Pipes and Flanagin references.

In particular, Applicant's independent claims 1, 12, and 17, include the limitation, or a limitation similar thereto, of a housing to have an electronic device docked into a notebook computer. Pipes, however, only teaches docking a portable computer into a server, rather than a notebook computer, as is claimed by applicant.

The Examiner states that one of ordinary skill in the art would have been motivated to replace the desktop disclosed in Pipes with a notebook computer because a notebook computer is more portable. However, to do so would destroy the intended function of Pipes.

If proposed modifications of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 Fed. 2d 810, 123 USPQ 349. (MPEP §2143.01).

The principle operation of Pipes is to provide a server that is able to dock a portable computer, so that the server would not have to have peripherals such a keyboard etc. Rather, a user could use the peripheral provided by the docked notebook and the processing power of the server docking the notebook.

Among the advantages of the invention are one or more of the following. A dedicated keyboard, mouse or display does not have to be purchased for the server. One portable computer may provide a keyboard, monitor, or mouse for any of several servers. (Col. 2, lines 7-11.)

As shown in FIGS. 1A and 1B, unlike a portable computer 200, a file server 100 does not typically require input/output (I/O) devices 230-232 (a monitor 231, a keyboard 230, and a mouse 232) that are typically part of the portable computer 200 because the server 100 normally does its work without the need for direct intervention between the server and the user. In the invention, when I/O devices are needed by the server 100, they can be provided from the portable computer 200 by docking it (mechanically and electrically connecting it) to the server 100. Once docked, the portable computer 200 may operate in a run time mode which permits the server 100 to access and directly use the I/O devices 230-232 as if the I/O devices 230-232 were part of the server 100.

Thus, additional I/O devices do not have to be purchased specifically for the server 100, reducing cost. When not docked to the server 100, the portable computer 200 may be used as a workstation of a Local Area Network (LAN) or a Wide Area Network (WAN) serviced by the server 100 or as a stand-alone portable computer. (Col. 2, lines 35-55.)

Therefore, to modify the server of Pipes to be a notebook computer, as claimed by applicant, would change the principle operation of Pipes to provide a server computer not having to have a variety of peripherals.

Although Pipes does fortuitously mention the conflicting statement that the first computer may be a portable computer, the statement is conflicting with the overwhelming primary teachings of Pipes (to have the first computer be a server to dock a separate portable computer.) The test of obviousness is what the teaching of the reference would have suggested to one skilled in the art, and where there are conflicting teachings the examiner is to weight the power of each when considering the teachings to one skilled in the art. (*In re Young*, 927 F.2d 588, 18 USPQ 2d 1089 (Fed. Cir. 1991)).

As a result, applicant's independent claims are patentable over Pipes in view of Flanagin. Moreover, applicant's remaining claims depend from at least one of the independent claims, as discussed above, and therefore also include the distinguishing limitation of the respective independent claim. The dependent claims are therefore also patentable over Pipes in view of Flanagin.

## IX. CONCLUSION

For all of the foregoing reasons, this Board is respectfully requested to remand this application to the Examiner for reconsideration consistent with an order that the Examiner pass this case to issuance unless a proper rejection to the claims can be made.

### CHARGE OUR DEPOSIT ACCOUNT

Please credit any surplus or charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: July 13, 2005



---

Gordon R. Lindeen III  
Registration No. 33,192  
Attorney for Applicant

2400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1030  
(303) 740-1980



## Appendix A

1. An electronic device comprising:

a housing to have the device docked into a notebook computer having a memory to store a first operating system;

an interface disposed on a surface of the housing to enable communication between the device and the notebook computer when the device is docked;

a memory to store a second operating system, the second operating system is smaller in size and provides less functionality than the first operating system ; and

a central processing unit (CPU) to operate as a system processor of the notebook computer when the device is docked and to operate as a system CPU of the device when the device is undocked.

2. The electronic device of claim 1, further comprising an input controller to receive input data into the device when the device is undocked.

3. The electronic device of claim 2, further comprising core memory to store the input data when the device is undocked.

4. The electronic device of claim 3, further comprising an output controller to provide output data from the device when the device is undocked.

5. The electronic device of claim 4, further comprising a visual display disposed on a surface of the housing, the visual display being coupled to the input controller to provide the input data via pen-based entries on the display and being coupled to the output controller to provide the output data via the display.

6. (Cancelled)

7. The electronic device of claim 1, further comprising a battery to provide power to the CPU when the electronic device is undocked.

8. The electronic device of claim 7, wherein the interface is coupled to the battery to charge the battery when the electronic device is docked.

9. The electronic device of claim 8, wherein the notebook computer is to provide power to the CPU when the electronic device is docked.

10. The electronic device of claim 9, wherein the CPU is to operate at a higher frequency and at a higher voltage when the device is docked than when the device is undocked.

11. The electronic device of claim 1, wherein the CPU is to operate at a higher frequency and at a higher voltage when the device is docked than when the device is undocked.

12. A notebook computer comprising:

a docking port to receive a hand-held core computer having a Central Processing Unit (CPU) to operate as a system CPU of the notebook computer when the device is docked, and to operate as a system CPU of the core computer when the core computer is undocked, the hand-held core including a memory to store a first operating system;

an interface in the docking port to enable communication between the core computer and the notebook computer when the core computer is docked; and

a memory to store a second operating system, the second operating system is larger in size and has greater functionality than the first operating system.

13. (Cancelled)

14. The notebook computer of claim 12, wherein the interface is to couple a power supply of the base computer to a battery in the core computer to charge the battery and to provide power to the CPU when the core computer is docked.

15. The notebook computer of claim 14, wherein the CPU is to operate at a higher frequency and at a higher voltage when the CPU operates as a system CPU of the notebook computer than when the CPU operates as a system CPU of the core computer.

16. The notebook computer of claim 12, wherein the CPU is to operate in one of a high power mode and a low power mode according to user preference.

17. A method of operating a computer system comprising:  
operating a Central Processing Unit (CPU) as a system CPU of a notebook computer when a core computer is docked in a docking port of the notebook computer, the notebook computer including a memory to store a first operating system; and  
operating the CPU as a system CPU of the core computer when the core computer is undocked, the core computer including a memory to store a second operating system, the second operating system is smaller in size and provides less functionality than the first operating system.

18. The method of claim 17, further comprising synchronizing memory of the notebook computer with memory of the core computer when the core computer is docked.

19. The method of claim 17, further comprising charging a battery in the core computer when the core computer is docked.

20. The method of claim 17, wherein operating the CPU as a system CPU of the notebook computer includes operating the CPU at a higher frequency and voltage than when operating the CPU as a system CPU of the core computer.

21. (Cancelled)